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EXAMINER

PHAM, THIERRY L

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/768,213

Applicant(s)

KUWANO ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 and 31-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 and 31-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

- This action is responsive to the following communication: an Amendment filed on 1/26/05 and Supplemental Amendment filed on 2/9/05.
- Claims 1-28, 31-56 are pending in application; Claims 29-30 have been canceled.
- Insufficient antecedent basis rejection for claim 12 as indicated in previous office action has been withdrawn.

#### ***Claim Objections***

Claim 31 is objected to because of the following informalities: Claim 31 cannot be dependent upon canceled claim 29. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-28, 31-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Lopresti et al (U.S. 5754308).

Regarding claim 1, Lopresti discloses a digital integrated apparatus (digital photocopier, col. 3, lines 50-67) capable of storing (stores via storage medium within photocopier, col. 2, lines 17-22, col. 7, lines 4-55 and col. 8, lines 5-13) storing documentary image data corresponding to some specific document input from a facsimile receiving means (digital photocopier includes facsimile function, fig. 3) as a documentary image input means, by attaching document ID (DocID software incorporated within the digital photocopier for encoding and assigning ID mark, col. 2, lines 48-67 and col. 8, lines 35-4) identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with

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document management means (manages via control panel, fig. 3), and outputting specified documentary image from output means based on said document ID as required, comprising:

- a document ID encoding means (DocID software incorporated within the digital photocopier for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;
- a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document; said
- output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, while storing it in said storing means (stores in its local storage location within copier itself, col. 7, lines 25-33), and said
- document management means for automatically storing (automatically saves a digital representation of document, col. 2, lines 17-22 and col. 7, lines 4-34) documentary image received by said facsimile receiving means.

Regarding claim 2, Lopresti discloses a digital integrated apparatus (digital photocopier, col. 3, lines 50-67) capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means (scanner, col. 4, lines 1-5) by attaching document ID identifying (assigning document with ID mark, fig. 2, col. 7, lines 35-55 and col. 8, lines 1-15) the documentary image data in at least one kind of storing means (stores via storage medium within photocopier, col. 2, lines 17-22, col. 7, lines 4-55 and col. 8, lines 5-13) controlling attribute information (i.e. document parameters, col. 8, lines 14-47) containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

- a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;

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- a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document, and
- said output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, while storing it in said storing means (stores in its local storage location within copier itself, col. 7, lines 25-33), wherein said documentary image includes only the attribute information of said specific document.

Regarding claim 3, Lopresti further discloses a digital integrated apparatus as defined in claim 1, wherein all pages (col. 6, lines 10-25) of said specific document are output together with said documentary image with document ID mark.

Regarding claim 4, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

- a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;
- a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document; and said
- output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, wherein only said documentary image with document ID mark is output.

Regarding claim 5, Lopresti further discloses a digital integrated apparatus as defined in claim 4, wherein said documentary image input means is an image reading means (scanner, col. 4, lines 1-5).

Regarding claim 6, Lopresti further discloses a digital integrated apparatus as defined in claim 4, wherein said documentary image input means is a facsimile receiving means (fig. 4, col. 4, lines 1-13).

Regarding claim 7, Lopresti further discloses a digital integrated apparatus as defined in claim 4, wherein said documentary image input means is a facsimile transmitting means (fig. 4, col. 4, lines 1-13).

Regarding claim 8, Lopresti further discloses a digital integrated apparatus as defined in claim 3, wherein said documentary image input means is a printed image receiving means from a computer (fig. 4, col. 8, lines 1-13).

Regarding claims 9-10, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

- an image reading means (scanner, col. 4, lines 1-5) as said document image input means, a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;
- a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by

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said document ID encoding means and documentary image data corresponding to said specific document, said

- output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, and said
- document management means (DocID software, col. 8, lines 35-65) for instructing output from said image reading means to be input directly in the pattern synthesizing means and a documentary image corresponding to said specific document to be printed out from the output means.

Regarding claims 11-13, Lopresti further discloses a digital integrated apparatus as defined in any one of claims 2, 4, or 9, wherein said document ID encoding means outputs document ID mark and position information including a form size and layout position to the pattern synthesizing means, and wherein said pattern synthesizing means determines a position of the document ID mark based on said position information (DocID comprising layout and input parameters, col. 6, lines 60-67 and col. 8, lines 14-34).

Regarding claim 14, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting specified documentary image from output means based on said document ID as required, comprising:

- a document ID encoding means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) for generating document ID mark corresponding to said document ID when storing documentary image data corresponding to said specific document in said storing means;
- a pattern synthesizing means (encrypting means for embedding ID mark onto the printed document, ref. 37, fig. 2, col. 2, lines 31-67) for synthesizing document ID mark produced by said document ID encoding means and documentary image data corresponding to said specific document, said

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- output means (printing means for printing document with ID mark, ref. #37, fig. 2, col. 2, lines 31-37) for outputting documentary image with document ID mark generated by said pattern synthesizing means, while storing it in said storing means, and
- a dialogue type operating means (DocID software for encoding ID mark, col. 2, lines 48-67 and col. 8, lines 35-48) capable of judging whether or not to add a documentary ID mark to the documentary image output from said output means.

Regarding claim 15, Lopresti further discloses a digital integrated apparatus capable of storing documentary image data corresponding to some specific document input from at least one kind of documentary image input means by attaching document ID identifying the documentary image data in at least one kind of storing means controlling attribute information containing that document ID with document management means, and outputting documentary image specified based on said document ID, by adding document ID mark corresponding to said document ID, from output means as required, comprising:

- a documentary image reading means (col. 4, lines 29-50) for reading ID mark printed on said documentary image with document ID mark;
- a document ID decoding means (decoding means, fig. 5) for decoding the read document ID mark into document ID, and;
- said document management means (control panel, fig. 3) for specifying, for the purpose of some specific processing, documentary image corresponding to either the document ID obtained from document ID decoding means (fig. 5) or the document ID input in character string directly from an input/output device, based on the selection a user makes with the input/output device between document ID mark input or character string input.

Regarding claim 16, Lopresti further discloses a digital integrated apparatus as defined in claim 15, wherein said specific processing is take-out of document by the output means (i.e. facsimile apparatus, fig. 4).

Regarding claim 17, Lopresti further discloses a digital integrated apparatus as defined in claim 16, comprising a document ID mark encoding means for generating document ID mark



based on said document ID to the documentary image taken out as a result of said take-out of document, and a pattern synthesizing means for combining said generated document ID mark and the target documentary image and transferring it to the output means (figs. 4-5).

Regarding claim 18, Lopresti further discloses a digital integrated apparatus as defined in claim 17, wherein said document ID encoding means outputs document ID mark and position information including a form size layout position (layout parameters, col. 6, lines 50-67) to the pattern synthesizing means, and wherein said pattern synthesizing means determines a position of the document ID mark based on said position information.

Regarding claim 19, Lopresti further discloses a digital integrated apparatus as defined in claim 15, wherein said specific processing is copying or moving of target documentary image data from specific type of storing means to other specific type of storing means (via network, fig. 4).

Regarding claim 20, Lopresti further discloses a digital integrated apparatus as defined in claim 15, comprising said document management means for transmitting to at least said input/output device, upon receipt of document ID corresponding to some specific document, a plural number of attribute information mutually linked to said specific document, in the case where said document management means controls the link information indicating that specific documentary image and other documentary image are related to each other in contents, and said input/output device for displaying the attribute information obtained from said document management means to the user for selection so that the user may select the target documentary image (fig. 3, cols. 5-6).

Regarding claims 21-24, Lopresti further discloses a digital integrated apparatus as defined in claim 15, wherein said specific processing is combination for mutually combining a plural number of documentary image data by the document management means (i.e. archive server, fig. 2, cols. 5-8).

Regarding claim 25, Lopresti further discloses a digital integrated apparatus as defined in claim 15, comprising a facsimile receiving means as said documentary image input means, and a facsimile transmitting means as output means, said document ID decoding means decoding the document ID mark attached to the documentary image received from the facsimile, and the document management means outputting image data corresponding to specific document, based on the document ID obtained as a result of said decoding, to a facsimile in a distant place through said facsimile transmitting means (figs. 4-5).

Regarding claim 26, Lopresti further discloses a digital integrated apparatus as defined in claim 25, comprising said document ID encoding means for generating a second document ID mark in a readable size (fig. 2) by reading a first document ID attached to the documentary image received from the facsimile according to the user's instruction from the output/input device, and a pattern synthesizing means for combining the generated second document ID mark with the target documentary image and transferring them to the output means (fig. 4-5).

Regarding claim 27, Lopresti further discloses a digital integrated apparatus as defined in claim 26, comprising said document ID encoding means for generating document ID mark corresponding to the document ID including password (col. 8, lines 13-35) input according to the user's instruction from the input/output device.

Regarding claim 28, Lopresti further discloses a digital integrated apparatus as defined in claim 26, comprising an input/output device capable of setting the number of output copies (fig. 3) for all pages of documentary image with document ID mark corresponding to specific documentary image and/or documentary image.

Regarding claims 31-56 recite limitations that are similar and in the same scope of invention as to those in claims 1-28 above and combination thereof; therefore, claims 31-56 are rejected for the same rejection rationale/basis as described in claims 1-28.

*Response to Arguments*

Applicant's arguments filed 1/26/05 have been fully considered but they are not persuasive.

- Regarding claims 1 & 29, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest that an inputted document image is outputted with an ID mark by the output means while the image data is stored in a storing means by the document management means and that the documentary image received by the facsimile receiving means is stored while being attached with the document ID.

In response, Lopresti explicitly teaches that an inputted document image is outputted with an ID mark (i.e. DocID 37 as shown in fig. 2) by the output means (i.e. copier 30, fig. 4) while the image data is stored in a storing means (image data along with DocID is stored in its local storage location within digital photocopier, col. 6, lines 30-35 and col. 7, lines 20-34) by the document management means. Please notes: Claim 29 had been canceled. Claim 1 is referred to “a digital apparatus” rather than a digital copy machine. Lopresti also teaches document image along with DocID is also stored in the archive server.

- Regarding claims 2 & 30, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest the inputted documentary image is being stored in the storing means, the image is outputted with the document ID mark and “wherein said documentary image includes only the attribute information of said specific document”.

In response, Lopresti explicitly teaches the inputted documentary image is being stored in the storing means (image data along with DocID is stored in its local storage location within digital photocopier, col. 6, lines 30-35 and col. 7, lines 20-34), the image is outputted (prints the subsequent original including a printed DocID, col. 6, lines 30-34) with the document ID mark and wherein said documentary image includes only the attributes information (i.e. pointer, col. 7, lines 30-34 and/or file identification information, col. 4, lines 35-45) of said specific document. According to the originally filed specification, attributes information includes Document ID, number of pages, image size, date of registration, destination of link, and etc as shown in fig. 7. Herein, Lopresti's pointer is equivalent to “destination of link” DocID is equivalent to Document

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ID. DocID includes identification of the person who generated the page, input location, input parameters, and etc. Please notes: Claim 30 had been canceled.

- Claims 9-10, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest the copying and archiving of a specific document is carried out by performing the storing of the documentary image and the printing of the documentary image with the ID marks simultaneously under the configuration that an output from the image reading means is directly to the pattern synthesizing means, and then is outputted by the output means.

In response, the examiner unable to locate any indication and/or limitations that storing the documentary image and printing of the documentary image with the ID marks “*simultaneously*” and “*archiving*”. Documentary image data can be printed and/or further encoded with DocID, col. 6, lines 26-35 and col. 7, lines 4-33.

- Regarding claims 11-13 and 39-41, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest a pattern synthesizing means to determine a position to attached with an ID mark, the document ID encoding means outputs the form size and the layout position information to the pattern synthesizing means.

In response, Lopresti explicitly teaches a pattern synthesizing means to determine a position to attached with an ID mark, the document ID encoding means outputs the form size and the layout position information to the pattern synthesizing means (DocID creation software can be installed at the copier, fax machine, computer, and/or server, and DocID creation software includes input location, page count layout, input parameters, and etc for generating DocID marks, col. 6, lines 65-67 and col. 8, lines 13-22.

- Regarding claims 14 & 42, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest a dialog type operating means for selecting whether or not to add an ID mark on an output.

In response, Lopresti explicitly teaches a dialog type operating means for selecting whether or not to add an ID mark on an output (i.e. Copy Mode only copying pages on the glass of the

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copier, col. 9, lines 18-20, and to add or not to add an ID mark to the document is entirely depends upon user's interests and can be performed manually).

- Regarding claims 15 & 43, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest a selecting step of designating a document either based on the decoding of ID marks or based on the direct input of the document ID.

In response, Lopresti explicitly teaches an digital photocopier for retrieving document data from server using decoded ID marks (col. 4, lines 60-65 and col. 6, lines 10-50) or using a DocID creation software installed within the photocopier for creating and generating DocID and stored in its local storage location (col. 8, lines 13-65).

- Regarding claims 20 & 48, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest a method of selecting a target document from a plurality of documents suggested to a user by displaying attribute of other documents in connection with the document ID.

In response, Lopresti explicitly teaches a method of selecting a target document from a plurality of documents (DocIDs, col. 7, lines col. 8, lines 13-34) suggested to a user by displaying attribute (i.e. location of documents stored, col. 8, lines 13-34) of other documents in connection with the document ID (col. 6, lines 11-26).

- Regarding claims 25 & 53, the applicants argued the cited prior art of record (US 5754308 to Lopresti et al) fails to teach and/or suggest that an ID mark contained in the documentary image received by the facsimile receiving means is decoded and then stored documentary image corresponding to the ID is sent to the sending end.

In response, Lopresti explicitly teaches an ID mark contained in the documentary image received by the facsimile receiving means is decoded (the copier decodes the DocID, col. 6, lines 63-65) and then stored documentary image (col. 4, lines 50-67 and col. 7, lines 4-35) corresponding to the ID is sent to the sending end (col. 4, lines 50-67).

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

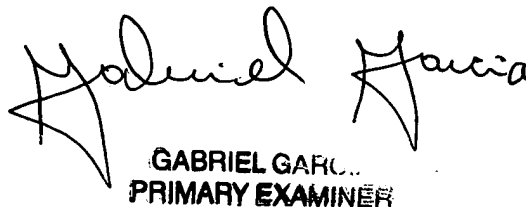
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham



GABRIEL GARCIA  
PRIMARY EXAMINER